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OFFICE OF PETITIONS

Perkins Coie LLP
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Washington DC 20005

In re Application of	:	
Schiemann et al.	:	DECISION
Application No. 10/583,689	:	ON APPLICATION FOR
Filed: June 20, 2006	:	PATENT TERM ADJUSTMENT
Atty Docket No. : 09097-	:	
8021.US00	:	
Title: 2-(HETERO)-ARYL	:	
SUBSTITUTED	:	
TETRAHYDROQUINOLINE	:	
DERIVATIVES	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)," filed November 17, 2010. Applicants request that the patent term adjustment be corrected from seven hundred and thirty-six (736) days to seven hundred and thirty-nine (739) days.

The request for reconsideration of the patent term adjustment under 37 C.F.R. § 1.705(b) is **DISMISSED**.

Applicants are given **TWO MONTHS** from the mail date of this decision to respond. No extension of time will be granted under 37 C.F.R. § 1.136.

On August 17, 2010, the Office mailed a "Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)," which indicated that the Patent Term Adjustment to date was 736 days. The present request for reconsideration, filed November 17, 2010, was timely filed as it was submitted concurrently with the issue fee. See § 1.705(b).

The record supports a conclusion that any patent issuing from this patent is not subject to a terminal disclaimer.

Rule 1.704(b) sets forth, in pertinent part:

an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an

application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

A non-final Office action was mailed on November 13, 2009, and a response was not received until February 16, 2010, which is three months and three days later. As such, a reduction of three days was assessed. Applicants have argued that this is improper, and that no reduction should have been assessed, since February 13, 2010 fell on a Saturday and February 15, 2010 fell on a federal holiday. However, Applicants will note that 35 U.S.C. 154(b)(2)(C)(ii)¹ does not require that a reply be filed in the Office within its three (3) month grace period, but simply specifies that there is a patent term adjustment reduction if a reply is not filed within this three (3) month period. Therefore, the "carry-over" provisions of 35 U.S.C. § 21(b)² does not apply to the three (3) month period in 35 U.S.C. 154(b)(2)(C)(ii).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

¹ "With respect to adjustments to patent term made under the authority of paragraph (1)(B), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of 3 months that are taken to respond to a notice from the Office making any rejection, objection, argument, or other request, measuring such 3-month period from the date the notice was given or mailed to the applicant."

² "When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day."

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3225.

/Paul Shanowski/
Paul Shanowski
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Office of Petitions